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Application No.: 10/020,401

Docket No.: 21547-00287-108

NOV 23 2005

REMARKS

This Amendment is being submitted concurrently with a Request for Continued Examination (RCE) in response to a Final Office Action.

Claims 11-19 remain pending in this application. Claims 11 and 16 are independent. Claim 11 has been amended, and no claims have been added or canceled by this amendment.

Written Description Rejection

Withdrawal of the rejection of claims 11-19 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement, is requested.

The Examiner asserted that the specification does not disclose that the center axes of each of the plural seats are non-parallel with each other, as recited in independent claim 11. Applicants' respectfully traverse this assertion.

The Examiner's attention is invited at least to the following numbered paragraphs (*emphasis added*), numbered with respect to U.S. Patent Application Publication 2002/0106612, *i.e.*, the present application:

"[0018] ...The implants have *individual inclinations on their centre axes*, and the centre axes for two of the implants are indicated by 8 and 9."

"[0021] In FIG. 2, the positions and inclinations of the seats are shown enlarged in relation to FIG. 1. In FIG. 2, two of the seats have been given reference labels 22 and 23 (cf. FIG. 1). The centre axes of the seats are indicated by 24 and 25, respectively. *These centre axes must be adapted with great precision to the corresponding axes of inclination of the implant* (cf. the centre axes 8 and 9 in FIG. 1)."

Further, FIGS. 1 and 2 support the above statements, and particularly support the recitation "wherein the center axes of each of the plural seats are non-parallel with each other", as claimed in independent claim 11.

Clearly, written description support is found in the Disclosure and, accordingly, withdrawal of the rejection and allowance of claims 11-19 are requested.

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Indefiniteness Rejection

Withdrawal of the rejection of claims 11-15 under 35 U.S.C. §112, second paragraph, as being indefinite, is requested. The Examiner asserts that it is unclear whether the implant is intended to be positively claimed in claim 11.

Claim 11 is drawn to an elongate support element *suitable for use with implants* and as a replacement structure for the human body, as in the preamble of the claim, and not to the implant itself.

Clearly, the claims are drawn to an elongate support element, and the recitation of "...suitable for use with implants..." constitutes a structural limitation on the elongate support element. In other words, if a elongate support element is *not* suitable for use with implants, then a structural limitation of the claim has not been met.

This structural limitation is linked to the preamble and is further defined in the body of the claim in the recitation of "plural seats penetrating a surface on the elongate support element and *enabling the support element to be applied to the implants*, center axes of each of the plural seats connecting with center axes of the implants to meet a fixed accuracy of fit requirement...", as recited in independent claim 11.

As required by the MPEP:

Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. *See, e.g., Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim."); *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990) (determining that preamble language that constitutes a structural limitation is actually part of the claimed invention). *See also In re Stencel*, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987). (The claim at issue was directed to a driver for setting a joint of a threaded collar, however the body of the claim did not directly include the structure of the collar as part of the claimed article. The examiner did not consider the preamble, which did set forth the structure of the collar, as limiting the claim. The court found that the collar structure could not be ignored. While the claim was not directly limited to

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the collar, the collar structure recited in the preamble did limit the structure of the driver. "[T]he framework - the teachings of the prior art - against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims are so limited." *Id.* at 1073, 828 F.2d at 754.).¹

In an effort to assist the Examiner in understanding the claimed invention and to expedite prosecution of this application, independent claim 11 has been clarified to recite "...plural seats penetrating a surface on the elongate support element and enabling the support element to be applied to the implants, center axes of each of the plural seats aligning with center axes of the implants to meet a fixed accuracy of fit requirement...wherein the plural seats are arranged to prevent communication by a through hole between the surface on the elongate support element and an opposing surface on the elongate support element through the plural seats...."

No new matter is involved with this claim amendment.

Comments Concerning Examiner's Response to Arguments

In reply to the Examiner's "Response to Arguments", Applicants point out that the word "communication" is well-known in the Patent Law (as well as elsewhere), including in innumerable issued patents. The phrase "no communication" refers to the fact that there is no through-hole between the surface on the elongate support element and an opposing surface on the elongate support element, as supported at least by FIGS. 2 and 3 of the present application.

Accordingly, since claims 11-15 claim an elongate support element in a definite manner, withdrawal of the indefiniteness rejection and allowance of claims 11-15 are respectfully requested.

Anticipation Rejection over Emmanuel (WO 94/15545)

Withdrawal of the rejection of claims 11-15 under 35 U.S.C. §102(b) as being anticipated by Emmanuel (WO 94/15545) is requested.

Applicant notes that anticipation requires the disclosure, in a prior art reference, of each and every limitation as set forth in the claims.² There must be no difference between the claimed

¹ See MPEP § 2111.02, "Effect of Preamble".

² *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985).

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invention and reference disclosure for an anticipation rejection under 35 U.S.C. §102.³ To properly anticipate a claim, the reference must teach every element of the claim.⁴ “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”.⁵ “The identical invention must be shown in as complete detail as is contained in the ...claim.”⁶ *In determining anticipation, no claim limitation may be ignored.*⁷

Deficiencies of Emmanuel

The Examiner asserts that, *inter alia*, Emmanuel FIG. 4 discloses elongate support element 48 comprising plural seats penetrating a surface on the element, and goes on to incorrectly assert that FIG. 4 shows *no communication* between the surface on the elongate element and an opposing surface of the element.

Further, the Examiner incorrectly asserts, without legal support, that “[p]atentable weight is not given to inferentially claimed components.”

However, the Examiner admits that Emmanuel does not show that the seats are parallel with each other.

The applied art does not disclose an elongate support element suitable for use with implants and as a replacement structure for the human body wherein, among other features, “...the plural seats are arranged to prevent communication between the surface on the elongate support element and an opposing surface on the elongate support element through the plural seats, and wherein the center axes of each of the plural seats are non-parallel with each other”, as recited in independent claim 11.

Referring to FIG. 2 of the present application, this limitation embodies the feature that the seats 22, 23 do not extend through the support element. In other words, the seats do not form through-holes, and do not allow communication between opposed surfaces of the support element.

³ *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991).

⁴ See MPEP § 2131.

⁵ *Verdegaal Bros. v. Union Oil Co. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

⁶ *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

⁷ *Pac-Tex, Inc. v. Amerace Corp.*, 14 USPQ2d 187 (Fed. Cir. 1990) (emphasis added).

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The Examiner offers FIG. 4 of Emmanuel as disclosing “no communication between the surface on the elongate support element and an opposing surface of the element.” Applicants respectfully traverse a continued mischaracterization of the applied art.

Emmanuel’s device, in contrast to the claimed invention, includes cylinder-shaped bores 56, which are open to the upper side of bridge 48, and which communicate with relatively narrow cylinder-shaped bores 58 which, in turn, open into dimples 50 via the flattened region 54.

Thus, as clearly seen in FIG. 4 of Emmanuel, *the structure of Emmanuel necessarily includes through holes 58 which allow communication between the upper surface of bridge 48 and the lower surface of bridge 48, i.e., the surface which is directly adjacent to the patient’s alveolar bone 60.*

Figure 4 is an elevation view showing bridge 48 of FIG. 3 connected to the dental patient’s alveolar bone 60 by screws 62 inserted through holes 56 and 58.

In particular, in FIG. 4 and the accompanying disclosure of Emmanuel, it can be seen that holes 58 in bridge 48 are *required* for screws 62 to be able to engage one-piece osseointegratable part 80, and thus secure bridge 48 to the patient’s alveolar bone 60.

Without the holes or “communication” in Emmanuel, the device of Emmanuel would not represent an operable or functional device because bridge 48 could not be secured to the patient’s alveolar bone 60.

Therefore, Applicants submit that it is clear that Emmanuel needs communication (*i.e., a required opening*) between the upper and lower surfaces of bridge 48, contrary to the explicitly claimed limitation in independent claim 11.

In addition, the Examiner states, without support, that “[p]atentable weight is not given to inferentially claimed components.” Applicants respectfully traverse this unsupported contention.

As the Court of Claims and Patent Appeals (CCPA), the predecessor to the Federal Circuit held in *Wilson*, “[a]ll words in a claim must be considered in judging the patentability of that claim

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against the prior art.⁸ Also, the MPEP requires that “[a]ny terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation.”⁹ Applicants submit that the Examiner must therefore consider each word of the claim in assessing patentability against the applied art. It appears that the Examiner has failed to do so in setting forth the basis for this anticipation rejection.

Because Emmanuel fails to disclose all of the limitations recited in claim 11, as discussed above, withdrawal of the rejection and allowance of claims 11-15 are requested.

Anticipation Rejection over Willoughby (US 5,873,721)

Withdrawal of the rejection of claims 11-15 under 35 U.S.C. §102(e) as being anticipated by Willoughby (US 5,873,721) is requested. The legal requirements for anticipation have been set forth above.

Further, the Examiner stated that “[p]atentable weight is not given to the new matter in the claims”, apparently with reference to the 35 U.S.C. §112 ¶1 written description rejection, discussed above. Since the 112, ¶1 written description rejection has been overcome, the Examiner is requested to consider each claim limitation, as required.

Deficiencies of Willoughby

The applied art does not disclose an elongate support element suitable for use with implants and as a replacement structure for the human body, which recite, among other features, that “...the center axes of each of the plural seats are non-parallel with each other”, as recited in independent claim 11, as amended.

In addition, the applied art does not disclose a method for producing and installing a tooth replacement structure which includes, among other features, “...applying tooth replacement material to the support part, wherein center axes of each of the two or more recesses are non-parallel with each other”, as recited in independent claim 16, as amended.

⁸ *In re Wilson*, 424 F.2d 1382 (C.C.P.A. 1970).

⁹ See MPEP §2111.02; and see *Corning Glass works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989).

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Willoughby clearly does not disclose use of non-parallel implant axes or recesses, and this claim limitation is not new matter, as written description support has been detailed, *supra*.

Since the applied art does not disclose all the recited limitations, withdrawal of the rejections and allowance of independent claims 11 and 16, and dependent claims 12-15 and 17-19, depending therefrom, are requested.

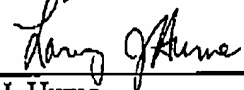
Conclusion

In view of the above amendment, applicant believes that each of pending claims 11-19 in this application is in immediate condition for allowance.

In the event the Examiner believes that an interview would be helpful in resolving any outstanding issues in this case, the undersigned attorney is available at the telephone number indicated below.

For any fees that are due, including fees for extensions of time and RCE, please charge CBLH Deposit Account No. 22-0185, under Order No. 21547-00287-US from which the undersigned is authorized to draw.

Respectfully submitted,

By 
Larry J. Hume

Registration No.: 44,163
CONNOLLY BOVE LODGE & HUTZ LLP
1990 M Street, N.W., Suite 800
Washington, DC 20036-3425
(202) 331-7111
(202) 293-6229 (Fax)
Attorney for Applicant